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APPLICATION NO. 17/254,771	FILING DATE 05/17/00	FIRST NAMED INVENTOR WENDLAND	ATTORNEY DOCKET NO. N 4080-29PUS
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EXAMINER

PRATT, C

ART UNIT

PAPER NUMBER

1771

10

DATE MAILED: 10/06/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

**Office Action Summary**

Application No.

09/269,771

Applicant(s)

WENDLAND, NIELS

Examiner

Christopher C. Pratt

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 June 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 7-12 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 7-12 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claims \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. § 119**

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- a) ☐ All b) ☒ Some \* c) ☐ None of the CERTIFIED copies of the priority documents have been:
1. ☐ received.
2. ☐ received in Application No. (Series Code / Serial Number) \_\_\_\_\_.
3. ☒ received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. & 119(e).

**Attachment(s)**

- 15) ☒ Notice of References Cited (PTO-892)                      18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      19) ☐ Notice of Informal Patent Application (PTO-152)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      20) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

1. The use of trademarks such as "Tivolmelt 9058/30" and "Helmitherm 42034" have been noted in this application. They should be capitalized wherever they appear **and be accompanied by their generic terminology.**

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

### ***Claim Objections***

2. Claim 2 is objected to because of the following informalities: The word "insoluable" should be spelled insoluble. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 7-12 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 7 requires a layer of adhesive applied to a glass fiber fabric, in which said adhesive is prevented from penetrating said glass fiber fabric.

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Applicant's specification does not contain any disclosure of any particular structure of said glass fiber fabric which would enable a person of ordinary skill in the art to produce such a fabric that is resistant to penetration by an adhesive. Is the fabric resistant to adhesive penetration because of a particular process of forming the fabric or is another material applied to the fabric to enable it to resist penetration? The current level of disclosure would lead a person of ordinary skill in the art to believe that any fabric containing glass fibers would resist adhesive penetration. Likewise applicant provides no disclosure of the particular adhesives used in the invention as set forth above, rendering claim 7 impossible to search over the prior art.

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 7-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 7 and 12 are indefinite because they recite the word "including." This word should be replaced with "comprising."

Claim 7 is indefinite because it recites the phrase "long-term adhesive." This phrase does not limit the metes and bounds of the claim. What length is "long-term?"

Claim 10 is indefinite because it recites the word "substantially" before impermeable. The word "substantially" does not limit the metes and bounds of the

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claim. It also contradicts claim 7, from which it depends. Claim 7 appears to require a fabric completely impermeable to an adhesive.

Claim 11 is indefinite because it recites the phrase "interrupted layer." How does applicant define this term? There is no definition found within applicant's specification. How is said adhesive interrupted?

***Claim Rejections - 35 USC § 102***

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claim 7 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over XP-002052603, XP-002052605, XP-002052604.

All of these patents are concerned with the creation of glass fiber fabric wallpaper sheet, comprising a sheet of glass fiber fabric having a pressure sensitive adhesive layer adhered thereto. Said adhesive is inherently prevented from penetrating the glass fiber fabric because these references all meet the limitations set forth in applicant's claims and specification. XP-002052603 specifically discloses an adhesive, which can not penetrate the glass fiber fabric because said fabric is pre-impregnated with a silicate.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 7-12 are rejected under 35 U.S.C. 103(a) as being unpatentable over GB-2171956 in view of XP-002052603, XP-002052605, XP-002052604.

GB-2171956 is concerned with the creation of wallpaper comprising a fabric and a water insoluble thermoplastic hot melt pressure sensitive adhesive (page 3, right hand column, line 103). A barrier paper is included between said paper and PSA so that no PSA penetrates said fabric. GB-2171956 does not seem to disclose the use of glass in the fabric.

XP-002052603, XP-002052605, XP-002052604 are all concerned with the creation of a wallpaper composed of glass fabric. It would have been obvious to person of ordinary skill in the art to combine the glass fabric of XP-002052603, XP-002052605, XP-002052604 in the wallpaper of GB-2171956. Such a combination would have been motivated by the reasoned expectation of providing the wallpaper of GB-2171956 with a stronger fabric.

GB-2171956 discloses a removable release film on said adhesive layer. With respect to claim 11, because of the confusion of the term "interrupted," as set forth above, it is the examiner's position that the presence of a release liner interrupts the adhesives ability to adhere to a surface.

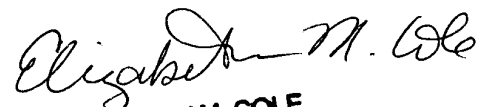
**Conclusion**

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Christopher Pratt whose telephone number is 703-305-6559. The examiner can normally be reached on Monday - Friday from 7 am to 4 pm.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, Terrel Morris can be reached on 703-308-2414. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2351.

Christopher C. Pratt  
October 5, 2000

  
ELIZABETH M. COLE  
PRIMARY EXAMINER